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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/723,790	11/28/2000	Pawan Chaturvedi	70000000-0006	7718

7590

02/15/2005

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EXAMINER

CHAN, WING F

ART UNIT

PAPER NUMBER

2643

DATE MAILED: 02/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/723,790

Applicant(s)

CHATURVEDI ET AL.

Examiner

Wing F. Chan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

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1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-26 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of copending Application No. 09/723,780. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are directed to the same invention of providing telephone call message translation between parties of a telephone call.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. Claim 19 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 19 is a single step claim, e.g. the claim recited. "establishing a communication...via Internet Protocol", which is a single step recitation that does not appear in combination with another recited step, and thus encompasses all possible conceivable means for performing a stated function. It is a claim, which depends on a recited property, a factual situation comparable to Hyatt; where the claim covers every conceivable step for achieving the stated property (result) while the specification discloses at most only those known to the inventor. Therefore, the specification is non-enabling for failing to disclose all possible steps for performing the stated function. In re Hyatt, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983).

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 9, 16, 23-26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed subject matter claimed "a human communications assistant" (claims 9, 16), "a call center operator" (claims 23-26), i.e. a human being, which is non-statutory subject matter.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent

granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-8, 10, 12-15, 17, 19-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Bossi et al (US PAT. NO. 6,421,425 filed 8/17/98, hereinafter Bossi).

As to claims 1, 12-15, 19-22, Bossi discloses a system and method for providing Internet-based telephone call message translation via a relay center 103 [call center] having message translator. Bossi teaches an Internet caller (first party) 102 accesses the ISP server 121 to establish a connection (communication link) via a message translator (protocol conversion server 113) to a called party (101) via one of an Internet protocol connection and data network (e.g. Internet 120). For example see Figs. 13, 4, col. 6 lines 3-27. Also, the communications link is provided when the first party 102 is the called party, e.g. see Figs. 2, 3, col. 4 line 38 to col. 6 line 2.

As to claim 2, note the communication link between called party 102 and message translator (protocol conversion server 113) is provided by communications carrier network 103.

As to claims 3, 7, 8, see Fig. 1, where ISP server 121 is the claimed server for providing an Internet protocol or network connection, computer 102 is the Internet communication device to the first party, an Internet connection is established between the first party and the server 121, a plain text connection is established between the server 120 and the relay center 104 which includes a message translator 113, PBX 105 is the claimed switching device for completing the communication link.

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As to claim 4, note col. 6 lines 10-15, Fig. 4 steps 402-404.

As to claims 5, 6, see Fig. 2 steps 201-206, col. 4 line 38 to col. 5 line 18 for example.

As to claims 10, 17, see Fig. 1, where relay center (call center) 104 comprises an automated message translator 113.

8. Claims 1-8, 10-15, 17-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Alcendor et al (US PAT. NO. 6,546,082 filed May 2, 2000, hereinafter Alcendor).

Alcendor discloses a system and method for allowing a caller to speak to the called party (destination) via the Internet using message translation (using TTS, STT). Alcendor teaches the caller uses a computer terminal 104 using Internet protocol and network connection to establish a call to the called party using text to speech, speech to text capabilities of the call center (relay center), and the center dials out to the called party via the PSTN. In Alcendor Fig. 1, all elements to the right of the PSTN/INTERNET 108 is the server, switching devices, etc. Note abstract, all Figs., col. 3 line 20 to col. 9 line 56.

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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10. Claims 9, 16, 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bossi in view of Ryan (US PAT. NO. 5,809,112).

Bossi differs from the claimed invention in not disclosing the message translator comprises a human communication assistant, call center operator. However, it is old and well known in the art that a message translator for a relay center (call center) can be either a human or an automated assistant, for example see Ryan col. 4 lines 18-38. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Bossi to comprise a human communication assistant, call center operator as is well known in the art since it is well known to use both a human or an automated assistant in providing communications to parties involved in a telephone call.

11. Claims 9, 16, 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alcendor in view of Ryan (US PAT. NO. 5,809,112).

Alcendor differs from the claimed invention in not disclosing the message translator comprises a human communication assistant, call center operator. However, it is old and well known in the art that a message translator for a relay center (call center) can be either a human or an automated assistant, for example see Ryan col. 4 lines 18-38. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Alcendor to comprise a human communication assistant, call center operator as is well known in the art since it is well known to use

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both a human or an automated assistant in providing communications to parties involved in a telephone call.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wing F. Chan whose telephone number is 703-305-4732. The examiner can normally be reached on Monday to Friday from 9 AM to 6 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz can be reached on 703-305-4708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Wing F. Chan
Primary Examiner
Art Unit 2643

12/16/04